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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,171	06/27/2003	Daniel D. Auger	DEP754NP	7798
27777	7590	11/01/2006	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			HOFFMAN, MARY C	
			ART UNIT	PAPER NUMBER
			3733	

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/609,171	Applicant(s) AUGER ET AL.	
	Examiner Mary Hoffman	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3 and 4 is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group I, claims 1-14, in the reply filed on 08/18/2006 is acknowledged.

Claims 15-26 are withdrawn (canceled by Applicant) from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 08/18/2006.

Claim Objections

Claim 2 is objected to because of the following informalities: Claim 2 recites the limitation "the femoral shim" in line 2. The claim should be corrected to recite --a femoral shim-- to be clearer for examination purposes.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 5-6, 10 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by White (U.S. Patent No. 5,662,656).

White discloses a kit (see FIG. 1) for locating a distal femoral resection plane in uni-compartmental knee surgery, the kit comprising: a shim including a shim arm (ref. #25) and a mounting member (ref. #85,87) connected to the shim arm; and a combination cutting and spacer guide including a cutting block portion (ref. #113) and a guide arm portion (ref. #79), the cutting block portion having an anterior side and a posterior side and surfaces defining a cutting guide slot (ref. #117) extending from the anterior side to the posterior side, the cutting guide slot lying in a plane defining the distal femoral resection plane, the guide arm portion having a posterior end spaced from the cutting block portion, a planar femoral surface extending outward from the posterior side of the cutting block portion to the posterior end, and a planar tibial surface extending from the cutting block portion outward to the posterior end, the planar femoral surface lying in a plane spaced from the plane of the planar tibial surface, the planes of the tibial surface and femoral surface being substantially parallel to and spaced from the distal femoral resection plane of the cutting guide slot; the combination cutting and spacer guide having a shim mounting opening; wherein the shim arm has a planar contact surface for contacting part of the guide arm (ref. # 53) and a planar contact surface for contacting part of one of the bones of the knee (ref. #31), the mounting member being sized and shaped to be receivable within the mounting opening of the combination cutting and spacer guide to removably mount the shim to the guide arm. The shim comprises a femoral shim and wherein the arm of the femoral shim has a surface area substantially the same as the surface area of the femoral surface of the guide arm of the combination cutting and spacer guide. The cutting block portion is

removably mountable to the femur. The cutting block portion includes a plurality of holes (ref. #133,143) extending from the anterior side to the posterior side for mounting the combination cutting and spacer guide to the femur, the kit further comprising anchoring members (ref. #129) receivable within the holes in the cutting block portion and a cutting member receivable within the cutting guide slot. The guide arm and shim are sized to be received on a single side of the tibia. The shim mounting opening of the combination cutting and spacer guide comprises an elongate slot extending from the medial to the lateral side of the guide arm. The guide arm comprises a pair of spaced parallel plates.

Claims 1, 5 and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Fargie et al. (U.S. Patent No. 4,736,737).

Fargie et al. a kit for locating a distal femoral resection plane in uni-compartmental knee surgery, the kit comprising: a shim including a shim arm (ref. #30) and a mounting member (ref. #28) connected to the shim arm; and a combination cutting and spacer guide including a cutting block portion (ref. #12) and a guide arm portion (ref. #38), the cutting block portion having an anterior side and a posterior side and surfaces defining a cutting guide slot (ref. #44) extending from the anterior side to the posterior side, the cutting guide slot lying in a plane defining the distal femoral resection plane, the guide arm portion having a posterior end spaced from the cutting block portion, a planar femoral surface extending outward from the posterior side of the cutting block portion to the posterior end, and a planar tibial surface extending from the cutting block portion outward to the posterior end, the planar femoral surface lying in a plane spaced from the plane of the planar tibial surface, the planes of the tibial surface

Art Unit: 3733

and femoral surface being substantially parallel to and spaced from the distal femoral resection plane of the cutting guide slot; the combination cutting and spacer guide having a shim mounting opening (holes in which ref. #28 are received); wherein the shim arm has a planar contact surface for contacting part of the guide arm and a planar contact surface for contacting part of one of the bones of the knee, the mounting member being sized and shaped to be receivable within the mounting opening of the combination cutting and spacer guide to removably mount the shim to the guide arm. The cutting block portion is removably mountable to the femur. The cutting block portion and the guide arm portion are integral. The cutting block portion has a bottom surface co-planar with the tibial surface of the guide arm. The guide arm and shim are sized to be received on a single side of the tibia.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-8 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over White (U.S. Patent No. 5,662,656).

White discloses the claimed invention except for the pair of spaced parallel plates being integral with the cutting block portion, and the cutting block portion and the guide arm portion are integral, and a tibial surface of the guide arm having a maximum

Art Unit: 3733

medial-lateral dimension of 32 mm and a maximum anterior-posterior dimension of 57 mm, the combination cutting and spacer guide having a maximum anterior-posterior dimension along the tibial surface of the distal side of the cutting block portion and the tibial surface of the guide arm of 67 mm, and the femoral surface of the guide arm having a maximum medial-lateral dimension of 17 mm and a maximum anterior-posterior dimension of 47mm.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of White with the pair of spaced parallel plates being integral with the cutting block portion, and the cutting block portion and the guide arm portion are integral, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

It would have further been obvious to one having ordinary skill in the art at the time the invention was made to construct the kit for locating a distal femoral resection plane of White with a tibial surface of the guide arm having a maximum medial-lateral dimension of 32 mm and a maximum anterior-posterior dimension of 57 mm, the combination cutting and spacer guide having a maximum anterior-posterior dimension along the tibial surface of the distal side of the cutting block portion and the tibial surface of the guide arm of 67 mm, and the femoral surface of the guide arm having a maximum medial-lateral dimension of 17 mm and a maximum anterior-posterior dimension of 47mm, since it has been held that where the general conditions of a claim are disclosed

Art Unit: 3733

in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fargie et al. (U.S. Patent No. 4,736,737).

Fargie et al. discloses the claimed invention except for the tibial surface of the guide arm having a maximum medial-lateral dimension of 32 mm and a maximum anterior-posterior dimension of 57 mm, the combination cutting and spacer guide having a maximum anterior-posterior dimension along the tibial surface of the distal side of the cutting block portion and the tibial surface of the guide arm of 67 mm, and the femoral surface of the guide arm having a maximum medial-lateral dimension of 17 mm and a maximum anterior-posterior dimension of 47mm.

It would have further been obvious to one having ordinary skill in the art at the time the invention was made to construct the kit for locating a distal femoral resection plane of Fargie et al. with a tibial surface of the guide arm having a maximum medial-lateral dimension of 32 mm and a maximum anterior-posterior dimension of 57 mm, the combination cutting and spacer guide having a maximum anterior-posterior dimension along the tibial surface of the distal side of the cutting block portion and the tibial surface of the guide arm of 67 mm, and the femoral surface of the guide arm having a maximum medial-lateral dimension of 17 mm and a maximum anterior-posterior dimension of 47mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Allowable Subject Matter

Claims 3 and 4 are allowed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

Art Unit: 3733

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Hoffman whose telephone number is 571-272-5566. The examiner can normally be reached on Monday-Friday 9:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MCH *mch*


EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER